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APPLICATION NUMBER 688 FILING DATE 09/23/00 LAI FIRST NAMED APPLICANT C ATTY. SOCKET NO. 100

STEPHEN E REITER
GRAY CARY WARE & FREIDENRICH LLP
SUITE 1600
4365 EXECUTIVE DRIVE
SAN DIEGO CA 92121

HM12/0925

EXAMINER

HIGEL, F

ART UNIT

PAPER NUMBER

1626

3

DATE MAILED: 09/25/01

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

- ☐ Responsive to communication(s) filed on _____
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire THREE month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 1 7 0 3 3 is/are pending in the application.
- Of the above, claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1 7 0 3 3 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☒ Notice of Reference Cited, PTO-892
- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 2
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

--SEE OFFICE ACTION ON THE FOLLOWING PAGES--

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Receipt is acknowledged of the information disclosure statement filed November 30, 2000, which has been entered in the file.

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1 to 33 are rejected under 35 USC 112, second paragraph for failing to properly define the invention. The expressions "a non-steroidal anti-inflammatory drug (NSAID)" "an optional spacer/linker", "optional", spacer/linker", "a sulfur-containing functional group containing an optionally substituted hydrocarby moiety", "functional group", "optionally substituted", "sulfonate, reverse sulfonate ... sulfonate or reverse sulfurate", "sulfonate or reverse sulfonate", "optionally substituted... alkyl sulfonate", optionally substituted... sulfone",

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“sulfonamide or reverse sulfonamide”, an optionally-substituted ... sulfonamide”, “sulfonate or reverse sulfonate”, “is optional”, “when present”, “ester, reverse ester ..., reverse amide”, “micelle”, “directly or indirectly covalently attaching” by the direct or indirect covalent attachment”, reducing the side effects” “enhancing he effectiveness of” “prevention or” and “altercating” render the claims indefinite by placing no definite limits or boundaries on the claims.

Claims 1 to 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Graham et al or Kaplan-Machlis et al, cited by applicants.

The references disclose that NSAID compounds having a sulfur-containing functional group such as a sulfide, sulfoxide or sulfonamide as please note Graham et al an pages 65, 67, 68 and 69 with respect to sulindac sulfoxide and sulindac sulfide and respect to Celecoxib and Rofecoxib. The claimed invention would be rendered obvious by the teachings of the references absent any showing of any unexpected or unobvious properties.

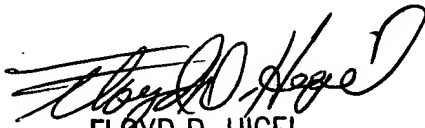
Sakaki et al, cited, show the state of the art.

No claim is allowed.

Any inquiry concerning this communication should be directed to Floyd D. Higel at telephone number (703) -308-4530.

Higel/LR

September 24, 2001


FLOYD D. HIGEL
PATENT PRIMARY EXAMINER
ART UNIT 123/626

